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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 575,580	05 22 2000	Frank McKeon	HMSU-P01-048	1156

28120 7590 06 03 2002

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ONE INTERNATIONAL PLACE  
BOSTON, MA 02110-2624

EXAMINER

KAM, CHIH MIN

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 06 03 2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/575,580

Applicant(s)

MCKEON ET AL.

Examiner

Chih-Min Kam

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-7 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.

Attachment(s)

1) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

2) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.

4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U. S. C. 121:

I. Claims 1-3, drawn to a nucleic acid comprising a nucleic acid sequence capable of hybridizing under stringent condition to a nucleotide sequence of SEQ ID NO:1, SEQ ID NO:2 or SEQ ID NO:3, classified in class 536, subclass 23.5.

Should Group I be elected, applicant is required to select one nucleic acid sequence (SEQ ID NO:1, SEQ ID NO:2 or SEQ ID NO:3). Each nucleic acid molecule is considered patentably distinct because each nucleic acid has different nucleotide sequence, different function and different utility. This is not species election.

II. Claim 4, drawn to a method of inhibiting calcineurin activity comprising administering a polypeptide comprising an amino acid sequence which is at least 80% identical to the polypeptide of SEQ ID NO:4, SEQ ID NO:5 or SEQ ID NO:24, classified in class 514, subclass 12, and class 530, subclass 350.

III. Claim 5, drawn to a method of treating a neurodegenerative disorder comprising administering a polypeptide comprising an amino acid sequence which is at least 80%

identical to the polypeptide of SEQ ID NO:4, SEQ ID NO:5 or SEQ ID NO:24, classified in class 514, subclass 12, and class 530, subclass 350.

IV. Claim 6, drawn to a method of treating an inflammatory disorder comprising administering a polypeptide comprising an amino acid sequence which is at least 80% identical to the polypeptide of SEQ ID NO:4, SEQ ID NO:5 or SEQ ID NO:24, classified

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V. Claim 7, drawn to a method of treating an autoimmune disorder comprising administering a polypeptide comprising an amino acid sequence which is at least 80% identical to the polypeptide of SEQ ID NO:4, SEQ ID NO:5 or SEQ ID NO:24, classified in class 514, subclass 12, and class 530, subclass 350.

Should Group II, III, IV or V be elected, applicant is required to select one amino acid sequence (SEQ ID NO:4, SEQ ID NO:5 or SEQ ID NO:24). Each amino acid sequence is considered patentably distinct because each peptide has different chemical property and produces different effect in the method of treatment. This is not species election.

2. The inventions are distinct, each from the other because of the following reasons:

The product of Invention I is distinct from the methods of Inventions II-V because the product of Invention I can be neither made by nor used in the methods of Inventions II-V.

The methods of Inventions II-V are distinct from each other because each Invention has different method steps, uses different materials and produces different outcome.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by the recognized divergent subject matter, and because Inventions I-V require different searches but are not co-extensive, examination of these distinct inventions would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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A telephone call was made to Jennifer Holmes on May 31, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, Ph. D. can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D. *CMK*  
Patent Examiner

May 30, 2002

*Christopher S. Low*  
CHRISTOPHER S. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1800